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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U. S. PATENT & TRADEMARK OFFICE
Applicant

Appl. No. : KUSUMOTO, et al.
09/522,296

Filed : March 09, 2000
Title : GOLF CLUB HEAD

Group Art Unit : 3711
Examiner : PASSANITI, S.

Docket No. : 08203.341

AP/3711
#15) Reply
Brief
1/23/03

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TC 3700 MAIL ROOM

REPLY BRIEF UNDER 37 C.F.R. § 1.193

January 15, 2003

Commissioner of Patents &
Trademarks
Washington, D.C. 20231

Dear Sir:

In response to the Examiner's Answer dated November 15, 2002, Appellant respectfully requests the Board of Patent Appeals and Interferences to consider the following additional arguments and reverse the decision of the Examiner in whole.

AP/3711
03/24/03 (SP)

REMARKS

The Examiner stated that the Appeal Brief did not contain a statement identifying the related appeals and interferences that would directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Applicant respectfully disagrees. The Applicant explicitly stated on page 2 of the Appeal Brief of October 9, 2002 that there were no known related appeals or interferences, which would directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

The Examiner maintains the rejection of claims 1, 6, 7, 8, 9, 10, 11, 12, 14, 15, 18, 28 and 29 under 35 U.S.C. 103(a) as being unpatentable over Mockridge '459 in view of Take '723, Helmstetter '806 and Drajan '033; claims 1, 2, 3, 5 and 16 under 35 U.S.C. 103(a) as being unpatentable over Endo ('097) in view of Take, Helmstetter and Drajan; claims 1, 13, 20 and 21 under 35 U.S.C. 103(a) as being unpatentable over Mockridge (GB 2,230,459) in view of Take, Helmstetter, Drajan and Minabe; and claims 2 and 4 under 35 U.S.C. 103(a) as being unpatentable over Mockridge (GB 2,230,459) in view of Take, Helmstetter, Drajan and Motomiya.

In the Appeal Brief of October 9, 2002, applicant argued that Mockridge '459 fails to disclose a golf club head comprising a cast body constituted by a hollow outer shell defining a top portion, a sole portion, a heel wall and a toe portion, and a shaft securing portion extended from the top portion to the sole portion and formed homogeneously with the hollow outer shell to provide a one-piece, unitary, homogenous body. By contrary, the golf club head of Mockridge '459 has the sole plate (18), as part of the second shell part (12), formed

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separately from the first shell part (11). The socket (19) is extended from the sole plate (18) to the top (14).

Endo '097 fails to disclose a golf club head comprising a cast body constituted by a hollow outer shell defining a top portion, a sole portion, a heel wall and a toe portion, and a shaft securing portion extended from the top portion to the sole portion and formed homogeneously with the hollow outer shell to provide a one-piece, unitary, homogenous body. By contrary, the golf club head of Endo '097 has the upper surface member 3 (top portion) formed separately from the rest of the head body 1.

Take '723 and Drajan '033 fail to disclose "a shaft securing portion formed adjacent to said heel wall and extended from said top portion to said sole portion..."

Helmstetter '806 fails to disclose a first hollow portion formed between the shaft securing portion and the heel wall of the head body.

Furthermore, the Examiner concedes that "the teaching references do not show a shaft securing portion extending from the top to the sole" (see page 11, lines 10-11 of the Examiner's Answer of November 15, 2002). Oddly enough, the Examiner states that this fact is irrelevant, even though the shaft securing portion extended from the top portion to the sole portion represents very important part of the claimed invention.

Therefore, even if the modification and combination of Mockridge '459 and Take '723 and/or Helmstetter '806 and/or Drajan '033 could be made, the resulting golf club head would lack the hollow outer shell including the sole portion, the shaft securing portion extended from the top portion to the sole portion and a first hollow portion formed between the shaft securing portion and the heel wall of the head body, wherein the shaft securing

portion is formed homogeneously with the hollow outer shell to provide a one-piece, unitary, homogenous body.

Moreover, neither Mockridge '459 nor Endo '097 provide any motivation or suggestion to combine the disclosure of any of the prior art references. Nonetheless, the Examiner stated in the Examiner's Answer of November 15, 2002, that the guidance provided to the skilled artisan by the teaching references to Take, Helmstetter and Drajan, it would have been obvious to the skilled artisan to make use of a homogeneous, unitary construction of the Mockridge or Endo device.

The Examiner's allegation is unsupported by the applied prior art and inconsistent with the disclosure of Mockridge '459 or Endo '097. Moreover, the Examiner's assertion that these references may be modified to achieve the limitations of the present invention would clearly result from **hindsight reconstruction**, which is not permitted. MPEP 2143.01 specifically states that the mere fact that references can be combined does not render the resultant combination obvious unless the references suggest the desirability of the combination, citing *In Re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The examiner may not, because of doubt that the invention is patentable, resort to unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173,178 (CCPA 1967). There is no suggestion to support the Examiner's assertion. The prior art references cited by the Examiner fail to disclose or suggest the desirability of modifying Mockridge '459 or Endo '097 to provide the one-piece, unitary, homogenous golf club head including the hollow outer shell including the sole portion, the shaft securing portion extended from the top

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portion to the sole portion and a first hollow portion formed between the shaft securing portion and the heel wall of the head body.

Therefore, the Applicant again points out to the fact that neither the prior art nor the knowledge generally available to one of ordinary skill in the art provides any suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and notice to that effect is earnestly solicited.

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